

REMARKS**I. Claim Rejections – 35 U.S.C. § 102*****Requirements for Prima Facie Anticipation***

A general definition of *prima facie* unpatentability is provided at 37 C.F.R.

§1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the Applicant needs to only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i. e.*, show that the prior art reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

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Luetzow

The Examiner rejected 1-3 and 6-9 under 35 U.S.C. 102(e) as being clearly anticipated by Luetzow (0030122641). The Examiner argued that Luetzow discloses the same invention as claimed: A magnetic linear displacement sensor comprising: a Hall element 126 having a sensor plate surface S; and at least one magnet (112,114) having a lengthwise dimension along which said Hall element detects a magnetic field component orthogonal to the sensor plate surface during displacement sensing, said magnet comprising first and second pole faces disposed on opposite lengthwise sides thereof and having a polarization axis D1 aligned orthogonally with respect to the lengthwise dimension, said first pole face opposing said Hall element and having a non-planar surface (paragraph 0052) contoured to generate a substantially linear orthogonal magnetic field component sensed by said Hall element during linear displacement sensing. The Examiner also cited PCT/ISA/220 (NPL dated 10-03-2005).

The Applicant respectfully disagrees with this assessment. The Rejection to claims 1-3 and 6-9 based on Luetzow fails under the application of the aforementioned prima facie obviousness test. That is, the Luetzow reference fails to disclose the claim limitations of amended claim 1, which indicate that the surface contour of the first pole face is bounded at the ends of the lengthwise dimension of said magnet by lateral edges, such that the contour of the first pole face is characterized as generally sloping upward from each of the lateral edges and peaking at approximately the midpoint between the lateral edges, and wherein the contour of the first pole face slopes upward from each of the lateral edges in a convex manner. Thus, the Luetzow reference cited by the Examiner fails to disclose every element in Applicant's amended claim 1 and hence also, claims 2-3 and 6-9, which depend from Applicant's amended claim 1. Based on the foregoing, the Applicant respectfully requests withdrawal of the rejection to claims 1-3 and 6-9.

II. Allowable Subject Matter

The Examiner indicated that claims 10-11, 13 and 18-19 are allowed.

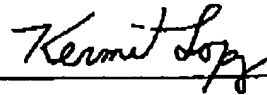
The Examiner objected to claims 4-5 as being dependent upon a rejected base claim, but indicated that such claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In light of this objection, the Applicant has amended claim 1 to incorporate all of the claim limitations of claims 4-5, which have been cancelled by amendment. Thus, claim 1 as constitutes a claim rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicant also submits that because claim 1 is now in an allowable form, any claims that depend from claim 1 should also be allowed.

III. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §102 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



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